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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,999	09/12/2003	Scott Trees	BAL6019P0022US	6084
32116	7590	02/01/2005	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			MCCORMICK EWOLDT, SUSAN BETH	
		ART UNIT	PAPER NUMBER	
			1654	
DATE MAILED: 02/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/660,999	TREES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Susan B. McCormick-Ewoldt	1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 November 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 62-86 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 62-86 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date November 23, 2004.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

Art Unit: 1654

**DETAILED ACTION**

The amendment of November 23, 2004 is hereby acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Status of Application*

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1654.

*Drawings*

Applicant will petition for color photographs as acceptable drawings under 37 CFR 1.17(h) upon allowance of the claims.

*Claims Pending*

Claims 62-86 will be examined on the merits as previously presented.

*Claim Rejections- 35 U.S.C. 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 65-67, 69, 74-77, 79, 82-84, 86 remains rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cosner (U.S. Patent No. 6,353,162) as previously stated in the prior office action dated August 24, 2004. Cosner discloses New Guinea impatiens plants having striped petals (referred to as "marbled"). See Figs. 2 and 3; col. 9, lines 2-4. Cuttings (col. 20, lines 34-37), pollen and ovules (col. 23, lines 17-25) are also disclosed. The claims do not recite any other characteristic that would distinguish the claimed plants from those of the prior art. Even if the claimed plants possess some characteristic not possessed by those of Cosner, the invention would still be obvious because Cosner teaches that mutagenesis is commonly used to produce sports (col. 2, l. 56-60).

The courts have approved the use of 102/103 rejection for product-by-process claims. See MPEP 2113.

Response to Arguments

**Applicant argues** that since the claimed plants are genetically altered in a cellular level, the claimed plants are not the same as those disclosed by Cosner. This is not persuasive as the claims encompass any New Guinea plant with a striped petal regardless of genotype.

Claim Rejections- 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill

in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 68, 78, 85 are rejected under 35 under U.S.C. 103(a) as being unpatentable over Cosner in view of Stephens *et al.* Cosner teaches New Guinea impatiens having striped flowers. Cosner does not teach cultures of regenerable cells from these plants. Stephens *et al.* teach using tissue culture in New Guinea impatiens as a means of asexual propagation (pg. 163). It would have been obvious to one of ordinary skill in the art at the time the invention was made to propagate the plants of Cosner using tissue culture as taught by Stephens *et al.*, with the advantages being: maintaining a virus-free stock, breeding programs can quickly be increased, certain genotypes are difficult to propagate by conventional methods and using less space (Stephens *et al.*, pg. 165). Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 62-64, 70-73, 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosner in view of Datta, Broertjes *et al* and Sharova *et al.* Cosner teaches New Guinea impatiens having striped flowers by disclosing x-rays and chemical mutagens have been used to produce sports, but does not teach the methods for doing so (col. 2, line 56). Datta discloses the use of gamma rays for changing the flower color; in particular, some cultivars show the petals having striped petals. (See examples on page 57, last paragraph; page 65, 3<sup>rd</sup> paragraph; page 68, 4th paragraph; page 69 last paragraph; page 170, last paragraph and page 174, various cultivars under “Rose”.) Broertjes *et al.* disclose production of petals that are striped in many different plants (dahlia on pg. 84 ‘Altamira’- orange and red strips; alstroemaria on pg. 154 ‘Zebra Stazeb’- heavily striped flower; carnation on pg. 159, ‘Sim Feu Follet’- large yellow flower with broad red flowers.). See Chapter 5. Sharova *et al.* disclose using chemical mutagens in addition to irradiation to cause “petal mottling” in balsam (see page 9, 3<sup>rd</sup> paragraph and Table 2). Balsam is in the *Balsaminaceae* family that also includes the New Guinea impatiens that has been developed from species of *Impatiens hawkeri*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use irradiation and/or chemical mutagenesis as taught by Datta, Broertjes *et al.* and Sharova *et al.*, with the motivation being to obtain an easily applicable, clean method with good

penetration of reproducibility, high mutation frequency and large economic importance to the horticulture industry (Broertjes *et al.* page 12-13). There would have been a reasonable expectation of success, because it was already known that striped petals could be produced in impatiens. Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

**Applicant argues** that the Stephens reference does not cure the deficiencies of Cosner. This is not persuasive as Cosner is not deficient because Cosner does teach New Guinea impatiens having striped flowers and Stephens teaches that tissue culture can be a means of asexually propagating New Guinea impatiens.

**Applicant argues** that the Datta, Broertjes *et al* and Sharova *et al.* references all teach using the claimed invention on plants other than New Guinea impatiens plants. This is not persuasive as Applicant has not explained why the methods in the prior art would not be expected to work with New Guinea impatiens plants. The mode of action (mutation) is the same, alteration of DNA at chromosome level and Cosner states "typically used" (column 2, line 56).

Applicant questions why one would do something inconvenient, unpredictable etc. The motivation would be if one doesn't already have a line of plants with the desired trait, just ~~█~~ breeding will not produce what one would want. Mutation is the means to introduce the striped trait into any New Guinea line of interest.

For the reasons discussed above and in the previous action, the rejections are deemed proper and are maintained.

Summary

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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